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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,827	03/30/2005	Franz-Leo Heinrichs	2002DE137	1656

25255 7590 10/17/2007  
CLARIANT CORPORATION  
INTELLECTUAL PROPERTY DEPARTMENT  
4000 MONROE ROAD  
CHARLOTTE, NC 28205

EXAMINER
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KATAKAM, SUDHAKAR

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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10/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/529,827	<b>Applicant(s)</b> HEINRICHS, FRANZ-LEO	
	<b>Examiner</b> Sudhakar Katakam	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of the Application**

1. Receipt of Applicant's Remarks and Arguments filed on 10<sup>th</sup> August 2007 is acknowledged. In view of applicants' amendments to the claim 1, the previous 112 2<sup>nd</sup> rejection has been withdrawn. However, the arguments for the 102(b) and 103(a) rejection are not found persuasive and as such, the following rejection has been maintained.

### ***Response to Arguments***

2. Applicant's arguments filed on 10<sup>th</sup> August 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation of "A pigment dispersing composition" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

Recitation of the intended utility into the preamble of a compound claim which can otherwise stand alone is not considered a further limitation of the claim. In re Ridden, 318 F 2d 761, 138 USPQ 112.

In addition to the above, applicants' argued that claims are not anticipated by the **Hirose et al** and none of the three references cited by the Office in support of 103 rejection provides any motivation for one with ordinary skill in the art to recognize a

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pigment dispersing composition can be made from the above referenced chemical compounds.

The examiner does not find these arguments persuasive. Applicants' claims are directed to a composition consisting of Component A, B, C, and D. **Hirose et al** clearly disclose all these components, viz., an ester of a polyhydric alcohol, viz., glycerol (3 hydroxy groups), and carboxylic acids, comprising of a fatty acid having 6 to 14 carbon atoms and a fatty acid having 15 to 28 carbon atoms. **Hirose et al** also further disclose that the esterification further having a dibasic acid, viz., adipic acid. The resultant esterification product has a hydroxyl value of 78. Applicants' amendment of the claims introduced the new preamble, viz., "A pigment dispersion composition". However, it does not give any meaning to the breadth of the claim.

The deficiencies in the **Hirose et al** have been cured by **Snel et al** and **Werner et al**. **Snel et al** teach an ester of a fatty acids, viz., mixture of Iso-stearic acid (18 carbon atoms) and montanic acid (28 carbon atoms) with a pentaerythritol [see Example I]. **Werner et al** teach mold release agent (processing auxiliary agent) for plastics, which mold release agent contains mixed esters of montanic acid, polyols and carboxylic acids with at least 10, preferably 14 to 25 carbon atoms [col. 1, lines 12-18 & col. 2, lines 21-46].

So, it would have been obvious to a person of ordinary skill in the art, at the time of invention was made, to have modified the references teachings by using an alternative polyhydric alcohol, in the production of ester, with a reasonable expectation of success. Also a person having ordinary skill in the art would have employed or

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explored the applications of esters as a plastic processing aid or dispersing agent that provide the most desirable results.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 5-7, and 9-10 are again rejected under 35 U.S.C. 102(b) as being anticipated by **Hirose et al** (US 5,436,006) for the reasons of record in the office action issued on 4/10/07.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-11, and 19 are again rejected under 35 U.S.C. 103(a) as being unpatentable over **Hirose et al** (US 5,436,006) in view of **Snel et al** (US 4,274,988) and **Werner et al** (US 4,581,387) for the reasons of record in the office action issued on 4/10/07.

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no even, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

#### ***Correspondence***

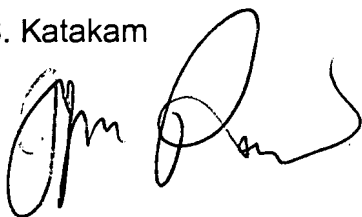
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Katakam

A handwritten signature in black ink, appearing to read 'J. Parsa', with a stylized, flowing script.

**J. PARSA  
PRIMARY EXAMINER**